

references when combined) must teach or suggest all the claim limitations. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. MPEP §2142, §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present Application, the Examiner has not established that the cited references teach or suggest all the claim limitations. In addition, the Examiner has not established that there is any suggestion or motivation to modify the references or to combine reference teachings to arrive at the claimed invention. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP §2142. Because this burden has not been met, the obviousness rejection is improper and should be withdrawn.

1. **The Examiner has not established that the cited references teach or suggest all the claim limitations**

Claims 1-9 are directed to a flavor enhancing oil that requires, *inter alia*, a matrix-forming material comprising silicon dioxide and at least one water soluble flavor enhancer. Dependent Claim 2 requires that the water soluble flavor enhancer comprise at least one nucleotide flavor enhancer. Dependent Claim 3 requires that the water soluble flavor enhancer comprise at least one amino acid flavor enhancer. Dependent Claim 4 requires that the nucleotide flavor enhancer is selected from the group consisting of disodium guanylate, disodium inosinate, and mixtures thereof. Dependent Claim 5 requires that the amino acid flavor enhancer comprise MSG. Dependent Claims 6-9 require particular ratios of disodium guanylate to disodium inosinate. Thus, to establish the *prima facie* case of obviousness, it is incumbent upon the Examiner to establish that the cited references teach or suggest a flavor enhancing oil comprising silicon dioxide and at least one water soluble flavor enhancer as recited by Claims 1-9. This the Examiner has not done.

The Examiner states that "Stoltz discloses a flavor enhancer formulation comprising oil and a flavor" and that "[t]he claims differ as to the use of specific flavor enhancers . . ." (12/5/01 Office Action, page 2) The Examiner does not point to, however, a water soluble flavor enhancer as required by Claim 1, such less to any of the specific flavor enhancers recited in Claims 2-9. Furthermore, without pointing to any references, the Examiner concludes that the claimed flavor enhancers are "notoriously well-known in the art" and are "used merely for their art-recognized function." (12/5/01 Office Action, page 2) In accordance with MPEP §2144.03, applicants respectfully request that the Examiner provide evidentiary support in documentary or affidavit form in support of the assertion that the required flavor enhancers are "well-known" and "used merely for their art-recognized function."

The Examiner states that "Patel et al disclose a flavor composition comprising silicon dioxide, where the silicon dioxide is used as a thickener." (12/5/01 Office Action, page 2) The Examiner does not, however, allege that Patel discloses a matrix-forming material comprising silicon dioxide, as is required by the present invention. As set forth in the claims, a matrix-forming material comprising silicon dioxide is required.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142, §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present case, the Examiner has not pointed to any references that teach or disclose the required flavor enhancers or matrix-forming material. Therefore, the Examiner's burden to establish the *prima facie* case has not been met. Accordingly, the obviousness rejection is improper and should be withdrawn.

2. **The Examiner has not established that there is any suggestion or motivation to modify the references or to combine reference teachings to arrive at the claimed invention**

Stoltz is directed to a dispensing system for vegetable oil sprays that comprise, *inter alia*, flavoring. (Stoltz, Abstract) Patel is directed to a chewing gum flavor ingredient; the flavor ingredient can comprise between 0.5-4% by weight of a thickener such as silicon dioxide. (Patel, Abstract) The silicon dioxide can be added to thicken and stabilize the flavor ingredient during processing. (Patel, Column 3, lines 6-9; Column 4, lines 46-64) The final flavor ingredient can be added to chewing gum to give high intensity, high quality, long lasting flavor. (Patel, Column 5, lines 28-30)

The Examiner concludes that it would have been obvious "to use any of the claimed flavor enhancers and silicon dioxide as taught by Patel et al in that of Stoltz because the use of flavor enhancers and the use of silicon dioxide is conventional in the art." (12/5/01, page 2) The fact that flavor enhancers and silicon dioxide may be "conventional" ingredients does not provide sufficient basis for concluding that one would have been motivated to modify Patel and Stoltz to arrive at the required water soluble flavor enhancer and matrix-forming material, then further combine them in such a way as to arrive at the present invention.

In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention. MPEP §2143.01. In the present case, the Examiner has impermissibly modified the reference teachings without identifying any prior art teachings that would motivate one skilled in the art to do so. Furthermore, the Examiner has not identified any teachings that would then motivate

one to combine the modified reference teachings to arrive at the claimed invention. Accordingly, the Examiner's rejection is improper and should be withdrawn.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to duplicate the claimed invention. *In re Fine, supra*. Rather, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). In the present case, no such reason for combining the cited references can be found. Thus, the combination of the references, and the conclusion that the present invention is obvious in view of them, is improper.

Furthermore, it is respectfully asserted that Patel is nonanalogous art and therefore is an improper reference upon which to base the obviousness rejection. In order to rely upon a reference under 35 U.S.C. §103(a), the "reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)

The present invention solves the problem of delivering water soluble flavor enhancers in an oil based form. (Application, page 3, lines 6-7; *see also* page 1, line 27 – page 3, line 5) In the present case, it is respectfully submitted that one skilled in the art, seeking to solve this problem, would not reasonably be expected or motivated to look to chewing gum flavor ingredients for a solution. Accordingly, the Examiner's rejection is improper and should be withdrawn.

#### CONCLUSION

The Examiner is respectfully requested to reconsider the Application in view of the foregoing Remarks and to allow all pending claims as patentable.

Respectfully submitted,

For: Zyzak et al.

By Melody A. Jones  
Melody A. Jones  
Attorney for Applicants  
Registration No. 44,175  
(513) 634-6944

Date: May 31, 2002  
Customer No. 27752